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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,655	02/25/2005	Kouichi Nakaoji	SAEG180.001APC	7988

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EXAMINER

CLARK, AMY LYNN

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/525,655

Applicant(s)

NAKAOJI ET AL.

Examiner

Amy L. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The non-final rejection written on 2 March 2006 and sent out on 14 March 2006 is vacated. Acknowledgement is made of the receipt and entry of newly amended claims filed on 25 February 2005, with amended Claims 2 and 4 and newly entered Claims 5-21. Claims 1-21 are currently under examination.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims Claims 1-6, drawn to a hair growth stimulant for oral use comprising at least one member selected from the group consisting of plants of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae* and extracts thereof.

Group II, claims 7-14, drawn to a method of stimulating hair growth comprising administering orally to a subject desired hair growth stimulation an effective amount of at least one member selected from the group consisting of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae* and extracts of the foregoing.

Group III, claims 15-21, drawn to a method of stimulating hair growth comprising providing an aqueous extract of at least one plant selected from the group consisting of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae*, administering an effective amount of the extract to a subject desiring hair growth on a daily basis and continuing oral administration at least 10 days.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is drawn to a hair growth stimulant for oral use comprising at least one member selected from the group consisting of plants of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae* and extracts thereof and a search for a composition comprising folic acid is not required for a search for a method of stimulating hair growth comprising administering orally to a subject desired hair growth stimulation an effective amount of at least one member selected from the group consisting of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae* and extracts of the foregoing, which is the special technical feature of Group II, nor is a search for a hair growth stimulant for oral use comprising at least one member selected from the group consisting of plants of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae* and extracts thereof co-extensive with a search for a method of stimulating hair growth comprising providing an aqueous extract of at least one plant selected from the group consisting of the genus *Orthosiphon* in the family *Lamiaceae* plants of the same genus *Vitex* L. in the family *Verbanaceae*, administering an effective amount of the extract to a subject desiring hair growth on a daily basis and continuing oral administration at least 10 days, which is the special technical feature of Group III, because the oral composition of Group I may be used in a manner different than that listed and the two methods provided are distinct from each other. Therefore, a search for the Invention of Group I is not co-extensive with a search for either Group II or Group III nor is a search for Group II co-extensive with a search for Group III.

Finally, Claim 1, at least, is anticipated by or obvious over Xiao (Reference U, CN 1078903 A). Xiao teaches a medicated wine comprising rice wine and chastetree fruit (which is synonymous with *Vitex agnus-castus*) for preventing and treating alopecia and poliosis. Consequently, the special technical feature which links the claims does not provide a contribution over the prior art, so the invention lacks unity.

The species are as follows:

Group I:

Specie A: elect at least one plant genus from Claim 1.

If *Orthosiphon* is elected as the genus, further elect at least one specie from Claim 2.

If *Vitex* L. is elected as the genus, further elect at least one specie from Claim 3.

Group II:

Specie A: elect at least one plant genus from Claim 7.

If *Orthosiphon* is elected as the genus, further elect at least one specie or aqueous extract of the specie from Claim 8 or Claim 10.

If *Vitex* L. is elected as the genus, further elect at least one specie from Claim 9 or 10.

Group III:

Specie A: elect at least one plant genus from Claim 15.

If *Orthosiphon* is elected as the genus, further elect at least one specie from Claim 16 or 18.

If *Vitex* L. is elected as the genus, further elect at least one specie from Claim 17 or 18.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims

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subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Group I:

Species A: drawn to claims 1-6.

Group II:

Species A: drawn to claim 7-14.

Group III:

Species A: drawn to claim 15-21.

The following claims are generic: claims 1, 7 and 15.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The plant genres listed in Claims 1, 7 and 15 and the plant species of Claims 2, 3, 8-10, and 16-18 are distinct both physically and functionally from each other. Furthermore, a search for one genus is not co-extensive with a search for another unrelated genus nor is a search for a genus co-extensive with a search for each and every species within that genus nor is a search for one species co-extensive with a search for every species within one genus nor is a search for one species co-extensive with a search for an unrelated genus and unrelated species within the unrelated genus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark
AU 1655

Amy L. Clark
July 13, 2006


MICHELE FLOOD
PRIMARY EXAMINER